

REMARKS

In the Office Action,¹ the Examiner rejected claims 38 and 39 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,306,940 to Yamazaki ("Yamazaki"). By this Amendment, Applicants amend claims 38 and 39, and added new claims 40 and 41. Support for the amendments can be found in, for example, FIG. 12.

Rejection of Claims 38 and 39 under 35 U.S.C. § 102(b)

Applicants respectfully traverse the Examiner's rejection of claims 38 and 39 under 35 U.S.C. § 102(b) as being anticipated by Yamazaki. In order to properly establish that Yamazaki anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that Yamazaki fails to teach or suggest each and every element of Applicants' claimed invention.

Claims 38 and 39, as amended, call for combinations including, for example, "said element isolating insulating film further having a side surface projecting above the top surface of said semiconductor layer wherein the side surface is substantially

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

perpendicular to the top surface of said semiconductor layer.” Yamazaki fails to disclose at least this claim element.

The Examiner argues that the claimed semiconductor layer is taught by N type epitaxial layer 103 of Yamazaki and that the claimed element isolating insulating film is taught by silicon oxide film 113, BPSG film 115c, and silicon oxide film 116a of Yamazaki. See Office Action, page 3. Applicants respectfully disagree. However, even assuming that references 103, 113, 115c, and 116a of Yamazaki cited by the Examiner could correspond to the claimed semiconductor layer and element isolating insulating film, Yamazaki still fails to teach or suggest “said element isolating insulating film further having a side surface projecting above the top surface of said semiconductor layer wherein the side surface is substantially perpendicular to the top surface of said semiconductor layer,” as recited in claims 38 and 39.

In an exemplary embodiment of the claimed invention depicted in Fig. 12, the top surface P_{ins} of the element isolating insulating film 62 is above the top surface P_{si} of the silicon layer 61. As such, the element isolating insulating film 62 has a side surface which projects above the top surface P_{si} of the silicon layer 61. Furthermore, this side surface is perpendicular to the top surface P_{si} of the silicon layer 61. See Applicants’ Fig. 12.

Contrarily, the top surfaces of silicon oxide film 113 and BPSG film 115c of Yamazaki are not above the top surface of N type epitaxial layer 103 of Yamazaki. See Yamazaki, Fig. 8C. In addition, the combination of the silicon oxide film 116a and the LOCOS type field oxide film 110 in Fig. 8C of Yamazaki, which could be argued to correspond to the claimed element isolating insulating film, does not have a side surface

that is perpendicular to the top surface of N type epitaxial layer 103. See, e.g., Yamazaki, Figs. 8C and 4B.

Accordingly, Yamazaki cannot constitute a teaching or a suggestion of "said element isolating insulating film further having a side surface projecting above the top surface of said semiconductor layer wherein the side surface is substantially perpendicular to the top surface of said semiconductor layer," as recited in claims 38 and 39. Yamazaki thus fails to anticipate claims 38 and 39. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 38 and 39 as being anticipated by Yamazaki.

Conclusion

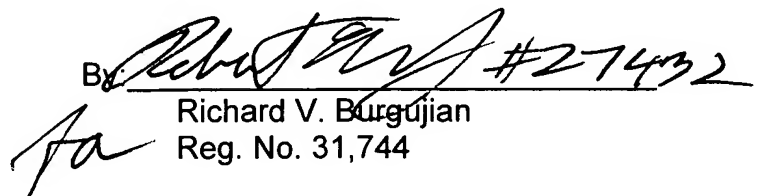
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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